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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,842	02/11/2002	Arturo A. Rodriguez	A-7496	6628

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SCIENTIFIC-ATLANTA, INC.
INTELLECTUAL PROPERTY DEPARTMENT
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EXAMINER

BUI, KIEU OANH T

ART UNIT PAPER NUMBER

2623

DATE MAILED: 09/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/073,842

Applicant(s)

RODRIGUEZ ET AL.

Examiner

KIEU-OANH BUI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/03/2004</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1 and 3 are rejected under 35 U.S.C. 102(e) as being anticipated by Wolff et al. (U.S. Patent No. 7,076,734 B2).

Regarding claims 1 and 3, Wolff discloses “a method implemented by a television set top box (STT), comprising determining by the STT that a television is on; and outputting by the STT an advertisement to the television, wherein the advertisement corresponds to a category of advertisements selected by a viewer of the television”, i.e., as shown in Fig. 1, a television set top box 14 is connected to a television 12 for providing programming and internet resources via lines 24 & 26, and the user controls the power on or off of the system 10 by using a remote controller 18; and the device 14 is shown in a closer look in Fig. 2 with details on input and output interfaces for receiving instructions and controls from the user to activate the system in receiving programs and/or advertisements (as shown in Figs. 4a-4B & 6A-6B, refer in col. 1/lines 15-42 for background on how to power on or off a television set using the user interface control for selecting a category or subcategories, as in col. 2/lines 11-52; and col. 6/lines 26-53

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& col. 7/line 57-67 for how the set top box operates; and col. 8/line 40 to col. 9/line 32 for the displaying of advertisements and the user selection of categories or subcategories0.

Claim Rejections - 35 USC 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2, and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff et al. (U.S. Patent 7,076,734 B2) in view of Thompson et al. (U.S. Patent 6,968,372 B1).

Regarding claims 2 and 4-5, Wolff does not show that the advertisement is keeping track by a counter and the set top box is outputting the advertisement responsive to the value of the counter whether it is being deleted or not; however, this technique of keeping track of advertisements, even the runtime capacity, the number of ads, ads being viewed and etc. is taught by Thompson (Fig. 1, col. 3/lines 1-11; col. 3/line 63 to col. 4/line 10; col. 11/line 60 to col. 12/line 17 with the increments in value, as shown in col. 15/lines 1-27; and as taught in col. 16/lines 26-43, the computer device 130 can be a set top box and/or micro processor computer-based systems in a variety of forms). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wolff's television set top box system with Thompson's teaching detailed technique in keeping track of number of advertisements in order to control and monitor effectively the advertisement processes in using a

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counter for counting the increment/decrement values of ads for advertising transactions within a computing/microprocessing computer and/or set top box system.

As for claim 6, Thompson further teaches this feature as the television is responsive to the predetermined user input being received by the STT during a predetermined period of time prior to output the advertisement (col. 3/lines 65 to col. 4/line 10 as the delivery goals of ads must be met for each advertisement based on the tracking of runtime capacity and the number of ad views, and/or ad impressions from the user predetermined inputs are determined).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Goode et al, Gordon et al, and LaRocca et al (PTO-892 attached) disclose systems related to electronic program guides for displaying category advertisements.

6. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to PTO New Central Fax number:

(571) 273-8300, (for Technology Center 2600 only)

*Hand deliveries must be made to Customer Service Window,
Randolph Building, 401 Dulany Street, Alexandria, VA 22314.*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krista Kieu-Oanh Bui whose telephone number is (571) 272-7291. The examiner can normally be reached on Monday-Friday from 9:30 AM to 7:00 PM, with alternate Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller, can be reached at (571) 272-7353.

The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Division or Art Unit 2623.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'K. Bui', with a long horizontal line extending to the right.

Kieu-Oanh Bui
Primary Examiner
Art Unit 2623

KB
August 31, 2006